



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/144,313	08/31/1998	JAY L. GAINSBORO	600-015	4672

758 7590 07/27/2005

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/144,313

Applicant(s)

GAINSBORO ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-24 and 26-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 6, 7, 9-24, 26-30, 35 and 39-45 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 31-34, 36-38 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claim(s) 2-3, 6, 12-13, 26 and 39-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang (US 5,274,698) in view of Richardson, Jr. et al. (US 5,355,403).

Regarding **claim(s) 2**, Jang discloses a method, provided by an institutional telephone system, of managing telephone activity between a calling party and a called party, wherein the calling party is an institutional party and the called party is a non-institutional party (FIG. 1 and column 1, lines 9-15), the method comprising:

providing an account for the calling party, wherein the account comprises calling party entitlements at least some entitlements are based on the calling party's class (FIGS. 4A-4E and column 7, lines 17-34) [The subscriber has an account with entitlements based on the class of the account whether it is A-E];

Jang discloses an outgoing call from the subscriber but fails to disclose creating an institutional communication connection with a calling terminal following initiation by the calling party, identifying the calling party and analyzing each external communication request received from the calling party to determine its called party parameters.

However, Richardson, in the same field of endeavor, teaches creating an institutional communication connection with an institutional terminal following initiation by the calling party, wherein the institutional communication connection comprises an external communication request from the calling party, the communication request

sufficient to establish communication between the calling party and the called party (column 6, lines 43-65);

identifying the calling party (column 7, lines 28-52);

analyzing the external communication request received from the calling party to determine its called party parameters (column 7, lines 53-65);

comparing the called party parameters to the entitlements to determine whether the calling party is entitled to communicate with the called party and denying the external communication request if the comparing returns a negative results (column 7, lines 53-65; and

determining whether the account is active and denying the external communication request if the determining returns a negative results (column 8, lines 2-8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang using the bridging node as taught by Richardson.

This modification of Jang enables the system to have controlled of the inmates calls so that the system would customize the billing-controlled call bridging system and diminished the inmate making nuisance calls.

Regarding **claim(s) 3**, Richardson teaches establishing the communication based on the comparing (column 6, lines 43-65).

Regarding **claim(s) 6**, Richardson teaches identifying the institutional terminal (column 6, lines 43-65);

determining whether the calling party is entitled to use the institutional terminal (column 7, lines 28-52); and

wherein the communication is denied if the determining returns a negative result (column 7, lines 28-52).

Regarding **claim(s) 12 and 41**, Jang discloses the account contains data representative of telephone numbers (column 7, lines 17-34).

Regarding **claim(s) 13**, Jang discloses the account contains data representative of personal identities (column 7, lines 17-34).

Regarding **claim(s) 26**, Jang discloses storing in the account data representative of the communication (column 7, lines 17-34).

Regarding **claim(s) 39**, Jang in combination with Richardson disclose all the limitations of **claim(s) 39** as stated in **claim(s) 2** and furthermore Jang discloses an interface component (200 on FIG. 1), a database (11 on FIG. 1) and a screen component (1 on FIG. 1).

Regarding **claim(s) 40**, Jang discloses a communications component, in communication with the screening with the screening component, and configured to process the communications request following determination by the screening component that the communication request contains permissible parameters (column 5, lines 22-32).

5. **Claim(s) 7, 11, 14-16, 21, 24, 27-28, 42 and 44-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson as applied to **claim(s) 2 and 39** above, and further in view of Hou et al. (US 5,325,421).

Regarding **claim(s) 7**, Jang in combination with Richardson as applied to **claim(s) 2** differ from **claim(s) 7** in that it fails to disclose initiating a second communication connection.

However, Hou teaches initiating a second communication connection (column 12, lines 11-23); and

bridging the communication connection with the second communication connection (column 12, lines 11-23).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson using the communications platform as taught by Hou.

Art Unit: 2645

This modification of Jang enables the system to have controlled of the inmates calls so that the system would customize the billing-controlled call bridging system and diminished the inmate making nuisance calls.

Regarding **claim(s) 11**, Hou teaches replaying a call origination message to the called party (column 12, lines 41-68).

Regarding **claim(s) 14**, Hou teaches the account contains data indicating whether to record a communication from the calling party (column 6, lines 42-61).

Regarding **claim(s) 15**, Hou teaches the account contains data indicating whether to record a communication to the called party (column 6, lines 42-61).

Regarding **claim(s) 16**, Hou teaches the account contains data indicating whether to monitor a communication from the calling party (column 10, lines 50-67).

Regarding **claim(s) 21**, Hou teaches providing administrative control to initiate recording of the communication (column 6, lines 42-61).

Regarding **claim(s) 24**, Hou teaches monitoring the communication for fraud detection event (column 1, lines 18-26).

Art Unit: 2645

Regarding **claim(s) 27**, Hou teaches storing a keyword in the account (column 5, lines 5-10).

Regarding **claim(s) 28**, Hou teaches monitoring the communication for the keyword (column 10, lines 28-32).

Regarding **claim(s) 42**, Hou teaches a digital conversion component configured to receive voice sample from the current calling party and convert the voice sample to a digital format (column 5, lines 19-24).

Regarding **claim(s) 44**, Hou teaches the digital conversion component is further configured to store the digital sample in a buffer (column 5, lines 1-4).

Regarding **claim(s) 45**, Hou teaches the database stores the digital sample in a file associated with the caller account (column 5, lines 1-4).

6. **Claim(s) 35** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson and in further view of Reuss et al. (US 5,844,978).

Regarding **claim(s) 35**, Jang in combination with Richardson disclose all the limitations of **claim(s) 35** as stated in **claim(s) 2** but fails to disclose a plurality of calling terminals, a plurality of telephone lines.

However, Reuss teaches providing a plurality of institutional terminals (14 on FIG. 1), a plurality of telephone lines (column 10, lines 22-23 "multiple telephone lines"), an administrative database (26 on FIG. 1), an administrative interface (30 on FIG. 1), wherein the database comprises an individual account (column 10, line 32 "an access code") for the calling party (column 10, line 32 "the user") and wherein each the account provides individual entitlements (column 10, line 38 "the line number") to each the calling party (column 10, lines 20-42) [The user can access multiple lines depend on the access code particular to the user].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson using the multi-user telephone line as taught by Reuss.

This modification of the invention of Hou enables the system to have multiple users so that the system would authenticate every user.

7. **Claim(s) 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson as applied to **claim(s) 2** above, and further in view of Morganstein (US 5,109,405).

Regarding **claim(s) 9**, Jang in combination with Richardson as applied to **claim(s) 2** differs from **claim(s) 9** in that it fails to disclose providing the called party with an option to prohibit any future calls from the calling party.

However, Morganstein teaches providing the called party with an option to prohibit any future calls from the calling party (column 8, lines 33-35).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson using the option to prohibit any future calls from the calling party as taught by Morganstein.

This modification of the invention of Jang enables the system to have option to prohibit calls from the calling party so that the system would control the outgoing call of every user.

Regarding **claim(s) 10**, Morganstein teaches providing the called party with an option to prohibit future calls from the location of the calling party (column 8, lines 66-67).

8. **Claim(s) 17-20 and 22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson as applied to **claim(s) 2** above, and further in view of Howe et al. (US 5,471,519).

Art Unit: 2645

Regarding **claim(s) 17**, Jang in combination with Richardson as applied to **claim(s) 3** differs from **claim(s) 17** in that it fails to disclose the account contains data indicating whether to monitor the calling party terminal.

However, Howe teaches the account contains data indicating whether to monitor the institutional terminal (column 8, lines 1-7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson using data indicating whether to monitor the calling party terminal as taught by Morganstein.

This modification of the invention enables the system to monitor the calling party terminal so that the system would control the outgoing calls of every user.

Regarding **claim(s) 18**, Howe teaches the account contains data indicating whether to monitor a communication to predetermined telephone numbers (column 7, lines 44-47).

Regarding **claim(s) 19**, Howe teaches the account contains data indicating whether to monitor a communication to the called party (column 7, lines 47-51).

Regarding **claim(s) 20**, Howe teaches the account contains data indicating a called party to whom communications should be not recorded (column 10, lines 26-28).

Art Unit: 2645

Regarding **claim(s) 22**, Howe teaches providing administrative control to initiate administrative monitoring of the communication (column 10, lines 34-38).

Regarding **claim(s) 23**, Howe teaches providing administrative control to terminate the communication (column 12, lines 9-17).

9. **Claim(s) 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson as applied to **claim(s) 2** above, and further in view of Matchett et al. (US 5,229,764).

Regarding **claim(s) 29**, Jang in combination with Richardson as applied to **claim(s) 3** differ from **claim(s) 29** in that it fails to disclose the identifying comprises biometric voice verification.

However, Matchett teaches the identifying comprises biometric voice verification (column 6, lines 49-52).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson using biometric voice verification as taught by Matchett.

This modification of the invention enables the system to use biometric voice verification so that the system would authenticate the user.

Regarding **claim(s) 30**, Matchett teaches the biometric voice verification occurs continuously during the communication (column 6, lines 62-64).

10. **Claim(s) 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jang in view of Richardson and in further view of Hou as applied to **claim(s) 42** above, and further in view of Matchett.

Regarding **claim(s) 43**, Jang in combination with Richardson and Hou as applied to **claim(s) 42** differ from **claim(s) 43** in that it fails to disclose performing biometric voice identification.

However, Matchett teaches the screening component is further configured to perform biometric voice identification on the sample generated by the digital conversion component and further configured to confirm an identity of the calling party based upon the results of the biometric voice identification (column 6, lines 49-55).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Jang in combination with Richardson and Hou using biometric voice verification as taught by Matchett.

This modification of the invention enables the system to use biometric voice verification so that the system would authenticate the user.

Allowable Subject Matter

11. **Claim(s)s 4, 8, 31-34, 36-38 and 46** are objected to as being dependent upon a rejected base claim(s), but would be allowable if rewritten in independent form including all of the limitations of the base claim(s) and any intervening claim(s)s.

Response to Arguments

12. Applicant's arguments with respect to **claim(s) 2-3, 6-7, 9-24, 26-30, 35 and 39-45** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2645

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

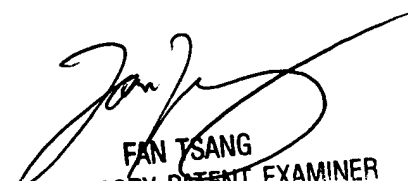
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
July 17, 2005


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER